

RCE/1724/14

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PTO/SB/30 (8/2000)

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REQUEST FOR CONTINUED EXAMINATION (RCE) TRANSMITTAL

Subsection (b) of 35 U.S.C. § 132, effective on May 29, 2000,
provides for continued examination of a utility or plant application
filed on or after June 8, 1995,
See the American Inventors Protection Act of 1999 (AIPA).

Application Number	09/652,272
Filing Date	August 31, 2000
First Named Inventor	Stevenson, S.
Group Art Unit	1724
Examiner Name	Hruskoci, P.
Attorney Docket Number	1843-A-DIV-CIP-DIV

This is a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114 of the above-identified application.

NOTE: 37 C.F.R. § 1.114 is effective on May 29, 2000. If the above-identified application was filed prior to May 29, 2000, applicant may wish to consider filing a continued prosecution application (CPA) under 37 C.F.R. § 1.53 (d) (PTO/SB/29) instead of an RCE to be eligible for the patent term adjustment provisions of the AIPA. See Changes to Application Examination and Provisional Application Practice, Final Rule, 65 Fed. Reg. 50092 (Aug. 16, 2000); Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office 47 (Apr. 11, 2000), which established RCE Practice.

1. Submission required under 37 C.F.R. § 1.114.

a. ☐ Previously submitted

i. ☐ Consider the amendment(s)/reply under 37 C.F.R. § 1.116 previously filed _____ on _____

ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____

iii. ☐ Other _____

b. ☒ Enclosed

i. ☐ Amendment/Reply

ii. ☐ Affidavit(s)/Declaration(s)

iii. ☒ Information Disclosure Statement (IDS)

iv. ☒ Other Response in Part to Public Protest

2. Miscellaneous

a. ☐ Suspension of action on the above-identified application is requested under 37 C.F.R. § 1.103(c) for a period of _____ months (Period of suspension shall not exceed 3 months; Fee under 37 C.F.R. § 1.17(e) required)

b. ☐ Other _____

3. Fees

The RCE fee under 37 C.F.R. § 1.17(e) is required by 37 C.F.R. § 1.114 when the RCE is filed.

a. ☒ The Director is hereby authorized to charge the following fees, or credit any overpayments, to Deposit Account No. 19-0083

i. ☒ RCE fee required under 37 C.F.R. § 1.17(e)

ii. ☐ Extension of time fee (37 C.F.R. §§ 1.136 and 1.17)

iii. ☐ Other _____

b. ☐ Check in the amount of \$ 355.00 enclosed

c. ☐ Payment by credit card (Form PTO-2038 enclosed)

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print / Type)

Daniel J. Long

Registration No. (Attorney / Agent)

29,404

Signature

Daniel J. Long

Date

August 17, 2001

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Name (Print / Type)

Karen L. Haines

Signature

Karen L. Haines

Date

August 17, 2001

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND Fees and Completed Forms to the following address: Assistant Commissioner for Patents, Box RCE, Washington, DC 20231.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sanford M. Stevenson

Serial No: 09/652,272

Examiner: Hruskoci, P.

Filed: August 31, 2000

Art Unit: 1724

For: METHOD AND APPARATUS FOR REMOVING METAL COMPOUNDS
FROM WASTE WATERAssistant Commissioner for Patents
Washington, D.C. 20231**RESPONSE IN PART TO PUBLIC PROTEST**
PURSUANT TO 37 CFR § 1.291RECEIVED
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Dear sir:

In response to the Public Protest Pursuant to 37 CFR §1.291 of July 31, 2001, applicant responds to Section II as follows. Applicant also requests an additional one month to respond to Section I and to the Petition to Institute Public Use Proceedings Pursuant to 37 CFR §1.292.

II. The Applicant has Satisfied his Duty of Candor.

With regard to the timing of the information disclosure statement, applicant's disclosure was highly regular and completely consistent with the timing requirements for consideration by the Office under 37 CFR §1.97(c)(2).

Timing requirements for consideration of information disclosure statements by the Office are defined in 37 CFR §1.97. Under 37 CFR 1.97(b) various times for making disclosures not involving recently discovered information or payment of additional fees,

e.g. before the first office action is received.

Under 37 CFR §1.97(c) which reads as follows two other options are allowed.

"An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of a final action under § 1.113, a notice of allowance under § 1.311, and it is accompanied by:

1. The statement specified in paragraph (e) of this section; or
2. The fee set forth in § 1.17 (p)." (Added 12/1/97).
(Emphasis added)

Under 37 CFR 1.97(c)(1) disclosures of information discovered within 90 days may be made after an office action. Under 37 CFR 1.97(c)(2) disclosures may also be made and be considered by the Office after the first office action with payment of the fee under 37 CFR 1.17(p). In this case, applicant made his disclosure under 37 CFR 1.97(c)(2).

The language used in 37 CFR 1.97(c) is the same as 37 CFR 1.97(b), i.e. "An information disclosure statement shall be considered by the Office...." Accordingly, there is no difference in the attention given by the Office to a disclosure under 37 CFR 1.97(b) and 37 CFR 1.97(c). Consequently, applicant's election to file his information disclosure statement under 37 CFR 1.97(c)(2) could in no way constitute a failure to comply with the duty of candor.

Because applicant's timing of his information disclosure statement was strictly in accordance with the Rules of Practice (37 CFR § 1.1 et seq.), his intent does not even have to be considered. Nevertheless, the applicant explains as follows his reason for filing his information disclosure statement at the time that he did.

Applicant's undersigned attorney is not representing applicant in his litigation.

Applicant has separate litigation counsel. Applicant has been active in assisting his litigation counsel with his case. In mid- November 2000 applicant attended a trial in his litigation. After this trial, applicant consulted with his litigation counsel in the preparation of briefs and such briefing was completed in about March 2001. Shortly after this trial, applicant discussed evidence presented with his undersigned attorney. During this conversation applicant had expressed the opinion that the EPA manual and the Inglis patent had been stressed by the defense. Applicant was advised that he needed to disclose this information and any other information which might be indicated to be material during briefing in his patent application. Applicant was also asked to send his undersigned attorney a copy of the EPA manual and to give his recommendation concerning the most pertinent sections thereof so as to avoid "burying " the most pertinent art by disclosing the entire manual. The initial office action was then received somewhat earlier than expected on December 28, 2001. Applicant sent the additional prior art references to his undersigned attorney who incorporated them in an information disclosure statement filed after the office action under 37 CFR 1.97(c)(2). It is noted that the disclosure of the request for quote from drawings had prior use, had previously been made and the examiner was being reminded of the same at this time. Contrary to petitioner's conjecture, applicant had not reached any agreement with the examiner concerning claim language or any other subject. In other words, the examiner had recommended claim language solely on his own initiative and without input from the applicant. In fact, there had been no written or verbal communications with the examiner after the filing of the application and before the issuance of the first office action. There was absolutely no intent to obtain less than full consideration of the additional references

by the examiner based on the time the information disclosure statement was filed.

Applicant contends that there is also absolutely nothing in Molins, PLC v. Textcon, Inc., 48 F.3d 1172, 33 USPQ2d 1823 (1995), cited in the petition, which supports a conclusion that the duty of candor was not satisfied in this case. Molins PLC v. Textcon, Inc. involved a factual situation in which an applicant for a patent (Molins) had failed to disclose an anticipating prior art reference of which he was aware. Molins then paid its issue fee and allowed the patent to issue without having made this disclosure. More than a year later, a reexamination under 35 USC §302 was commenced. During this reexamination, Molins did disclose the earlier omitted prior art reference along with a large amount of other in prior art in which the earlier omitted reference has "been alleged to have been buried". Under these circumstances, it was held that a disclosure made after issuance of a patent, during reexamination, could not satisfy the duty of candor. On the other hand, a failure to satisfy the duty of candor may be cured during prosecution and before a patent issues. Rohm & Haas Co. v. Crystal Chem. Co., 722 F.2d 1556, 220 USPQ 289 (Fed. Cir. 1983) cert. denied, 469 U.S. 851 (1984).

The applicant also points out that Molins, PLC v. Textcon, Inc. was decided before 37 CFR § 1.97 (c) was added to the Rules of Practice (37 CFR § 1.1 et seq.) on December 1, 1997. This case is, therefore, inapposite for this additional reason.

With regard to the opinion, applicant points out that he had already clearly and unambiguously disclosed that there was a request for quote from drawings and prior use before the critical date. As applicant understands Pfaff v. Wells Electronics Inc., 119 S. Ct. 304, 48 USPQ2d 1641 (1998) such a request for quote alone within the scope of the claims is all that is necessary to establish the on-sale bar as long as the invention is

ready for patenting. Consequently information of subsequent commercial activities would have been more than what was necessary to establish the on-sale bar and thus not material. The applicant also points out that the scope of the claims considered in the opinion was considerably broader than the scope of the claims presented in this application. Furthermore, as applicant understands the opinion, no final decision was made concerning the claims considered therein.

Nevertheless, if the entire opinion is considered material, applicant did not intend to fail to disclose any material information. Intent is an essential element of a failure to satisfy the duty of candor. Kingsdown Medical Consultants, Ltd. v Hollister Inc., 863 F.2d 867, 9 USPQ 2d 1384 (Fed. Cir. 1988), cert. denied, 490 U.S. 1067 (1989). To be frank, when applicant considered what needed to be included in the information disclosure statement, prior art references were considered and the opinion was not thought of or discussed. It is obvious that applicant would not have intentionally failed to disclose any material prior art or other information since he knew there was a strong possibility that litigation counsel might want to soon enter this application into evidence in his litigation.

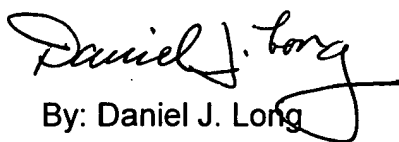
For the purposes of considering the equities of this matter, it is also noted that applicant is an independent inventor having only relatively limited resources. Applicant has attempted to be honest and diligent in identifying and disclosing possibly material prior art or other information, and believes that his above described efforts have been reasonable under the circumstances.

Nevertheless, to eliminate any doubt that all material prior art or other information has been disclosed, applicant is filing herewith a request for continuing examination under 37 CFR § 1.114 and an information disclosure statement including the

opinion. The applicant refers to the above comments concerning the pertinency of the additional information so as to cure any deficiency in prior information disclosure statements under Rohm & Haas Co. v. Crystal Chemical Co., 722 F.2d 1556, 220 USPQ 289 (Fed. Cir. 1983) cert. denied, 469 U.S. 851 (1984).

Respectfully submitted at Canton, Ohio this 17th day of August, 2001.

SAND & SEBOLT

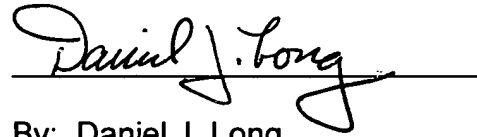

By: Daniel J. Long

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DJL/klh

CERTIFICATE OF SERVICE

In accordance with 37 CFR § 1.292 (a)(4), this response is being served by first class mail on Cameron Elliot Esq. and Louis A. Tarasi, Jr. Esq. on August 17, 2001.

A handwritten signature in cursive script, reading "Daniel J. Long", is written over a horizontal line.

By: Daniel J. Long